

## REMARKS

The Applicants respectfully request amendment to the specification at page 3, lines 4-9, and at page 4, line 16 to page 5, line 9, where reference to a lamination stack has been added. Support for these amendments is found in the originally filed drawings, in which a lamination stack is clearly shown as a part of motor assembly (15), although not positively identified. Such a lamination stack is a well known component of a motor assembly as described and claimed in the present application, and its presence in Fig. 1 would be apparent to persons of ordinary skill in the art. As such, the Applicants do not believe that any new matter is added by the amendments to the specification shown herein. A replacement drawing sheet showing Figure 1 has been provided herewith showing the numeral 19 which identifies the lamination stack.

Claims 1-5, 7-9, and 24 have been rejected as unpatentable over the patent to Wentz, U.S. Patent No. 5,567,127 in view of the patent to Morimoto et al., U.S. Patent No. 5,219,648. The remaining claims have also been rejected as being unpatentable over the aforementioned references and in further view of the patent to Finkenbinder et al., U.S. Patent No. 6,703,754; and U.S. Patent Publication No. 2004/0165986 to Parker et al. In rejecting all of the pending claims, the Office Action asserts that Wentz teaches that a part of the motor assembly, the leads, contacts the sleeve. In reaching this interpretation of Wentz, the Examiner has considered the motor leads, with or without insulation, as a part of the motor assembly. It is noted, however, that claim 1 as previously submitted, called for a motor assembly comprising an electric motor and windings, and a self-extinguishing flame and noise suppression *sleeve in contact with one of said electric motor and said windings*, and not a *sleeve in contact with the motor assembly*, as stated by the Examiner.

Upon consideration of the cited references, the pending application, and the Examiner's comments, the Applicants respectfully request entry of an amendment to claim 1 to clarify the point of contact between the sleeve and the motor assembly. Claim 1 has been amended to require a motor assembly having an electric motor, a *lamination stack* and windings, and to further require that a self-extinguishing flame and noise suppression sleeve contact one of said *lamination stack* and said windings. Support for the amendment is found at least in Fig. 1 of the originally filed drawings, where sleeve (16) is shown

contacting lamination stack (19), as described in the amendments to the specification above.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Last, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectations of success must both be found in the prior art, and not based on the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In regard to establishing a *prima facie* case of obviousness, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliably suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

It is respectfully submitted that the proffered combination of Wentz and Morimoto does not teach all of the elements of the claimed invention and, specifically, the limitation regarding the sleeve being in touching contact with at least one of said *lamination stack* and said windings. The amendment to claim 1 narrows the scope of the claim in that it further specifies the contact point with the sleeve. In light of the Examiner's remarks in the office action, and upon review of Wentz, the Applicants do not believe that Wentz teaches a sleeve in contact with a lamination stack of a motor assembly. Even if the leads are interpreted as a part of the motor assembly of Wentz, they cannot be considered the equivalent of a lamination stack. Therefore, the combination of Wentz with any of the additional references listed above fails to teach all of the elements of claim 1. With it being the position of the Applicants that claim 1 is allowable, it is submitted that all claims depending therefrom are likewise allowable.

While it is believed that claim 5 is allowable for the reasons stated above, the Applicants also believe that claim 5 is allowable on its own merit. Claim 5 calls for a

sleeve having a cover hole therethrough and wherein said motor assembly extends through said cover hole. The Examiner has not provided a specific indication of where any of the references disclose such a sleeve having a hole, and a motor assembly extending through the hole. After reviewing the cited references, the Applicants do not believe that the limitation of claim 5 is taught by Wentz, or any of the other cited references.

It is noted that a new claim 24 was submitted previously which calls for a motor assembly as defined in claim 1, wherein said motor assembly is provided without a sensor to maintain the motor at a limited temperature. As stated in the remarks accompanying the submission of claim 24, none of the references made of record teach or suggest a sleeve in touching contact with one of the electric motor and winding and which is provided without a sensor to maintain the motor at a limited temperature. While new claim 24 has been rejected in view of Wentz and Morimoto, no indication has been provided where the references make such a teaching. The Applicants respectfully request that the Examiner specify where the references teach or suggest a sleeve in touching contact with one of the electric motor and winding and which is provided without a sensor to maintain the motor at a limited temperature.

In view of the foregoing amendments and arguments presented herein, the Applicants believe that they have properly set forth the invention and accordingly, respectfully request the Examiner reconsider and withdraw the rejections provided in the last Office Action. A formal Notice of Allowance of claims 1-5, 7-15, and 24 is earnestly solicited.

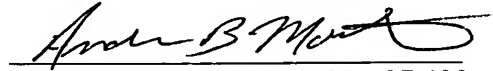
In the event that a fee required for the filing of this document is missing or insufficient, the undersigned Attorney hereby authorizes the Commissioner to charge payment of any fees associated with this communication or to credit any overpayment to Deposit Account No. 18-0987. If a withdrawal is required from Deposit Account No. 18-0987, the undersigned Attorney respectfully requests that the Commissioner of Patents and Trademarks cite Attorney Docket Number **4570.94** for billing purposes.

Should the Examiner deem a telephone call to be beneficial in resolving any remaining matters, or to place the claims in better form for allowance, the same would be

Application No.: 10/816,609  
Reply to Office Action of October 15, 2007  
Attorney Docket No. 4570.94

greatly appreciated.

Respectfully submitted,



Andrew B. Morton, Reg. No. 37,400  
Renner, Kenner, Grieve, Bobak, Taylor & Weber  
First National Tower 4th Floor  
Akron, Ohio 44308-1456  
Telephone: (330) 376-1242  
Facsimile: (330) 376-9646  
Email: [morton@rennerkenner.com](mailto:morton@rennerkenner.com)

Attorneys for Applicant

Attorney Docket No: 4570.94